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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,107	03/03/2004	Michelle Grandy	20119-0003	4100

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EXAMINER

LE, TAN

ART UNIT PAPER NUMBER

3632

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/792,107	GRANDY, MICHELLE	
	Examiner	Art Unit	
	Tan Le	3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,10,13,14,17,18 and 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9,11,12,15,16,19-22 and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the second office action for application No. 10/792,107. This application contains claims 1-31. Claims 15-31 have been added.

Election/Restrictions

2. Applicant's election with traverse of Group I, the species of Figures 1-2 in the reply filed on 2/15/06 is acknowledged. The traversal is on the ground(s) that the election requirement should be withdrawn because there is no serious burden if election is not required". This is not found to be persuasive because applicant has fail to show why the instant claims of Group I and Group II are not patentably distinct and the reason why there is not a serious burden involves in the field of a search between two Groups of two separate status claims locate in two separate classes of classifications. It should be noted the determination of whether or not there is a serious burden involves in searches relate with questions of (1) Separate status in the art, (2) Different classification, (3) Divergent fields of searches, (4) Search required for one group not required for the other...as set forth under Section 803. Nevertheless, one must take into account the burden of having to consider and examine all separate issues of the apparatus claims and the method claims that are shown in two separate statuses in the art locate in two different classifications and the search requires for Group I may not require for Group II. Further, it should be noted that patentability of an apparatus claim is based on the structure of that apparatus while the patentability of method claim is based on the recited method steps. Thus, it is quite evident that two separate issues of patentability must be searched for and considered. Clearly, this imparts a serious

burden on the Examiner to have to examine two patentably distinct inventions in the same application. The requirement is still deemed proper and is therefore made FINAL.

With respect to the elected embodiment, applicant indicated that claims 1-8, 12-16 and 19-31 are readable thereon. However, claims 13-14 and 23-26 are directed toward group II, which is not elected by Applicant. Also Claims 7-8 are directed to Figures 3-6 which is not belonged the embodiment elected; and claims 10 and 17-18 are directed toward Figures 7 or 8 which is also not the embodiment elected. Only claims 1-6, 9, 11, 12, 15-16, 19-22 and 27-31 are readable to the elected species. Accordingly Claims 7-8, 10, 13-14, 17-18 and 23-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species/group, there being no allowable generic or linking claim.

3. Amendment/Changes to specification, abstract and drawings are not approved because of the following reasons:

- a) The abstract must be provided on a separate page
- b) The specification must show how "any combination of the plate, the ring piece and the first mounting piece are detachable" such as the in the form of quick connect/disconnect, screws, adhesive/glue, socket and/or groove type or any other alternative method and the drawings must show exactly as described.

Drawings:

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "any combination of

the plate, the ring piece, and the first mounting piece being detachable" (from claim 3) must be shown or the features canceled from the claim(s). No new matter should be entered.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the first mounting piece being detachable from the ring piece" as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP 1608.02(d). The applicant must not add any new matter. It appears from the drawings that the first mounting piece and ring piece are simply one-piece with each other, and in no way detachable.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary, to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. .

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases, which can be implied, such as. "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes." etc.

In the abstract. line 2, "is provided" should be removed.

The disclosure is objected to because of the following informalities:

In paragraph 19, lines 2-4, it is unclear how the plate, ring piece and first mounting piece can be detachable from the basket holder. The plate, ring piece and first mounting piece ARE the basket holder. How can something be detachable from itself?

In line 5. "230" should be --220--.

Appropriate correction is required.

Claim Objections

6. Claim 11 is objected to because of the following informalities: Claim 11, line 2, "mounting piece" should be changed to – mounting pieces--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is repeatedly rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 3, the specification merely recited first that the "plate, ring piece, first mounting piece are detachable from the basket holder" (this is ambiguous in itself, and that the first mounting piece may be detachable from the ring piece." In no way did the written description specifically describe or the drawings show exactly how "any combination of the plate, the ring piece, and the first mounting piece are detachable." as specified in claim 3.

Therefor, the Examiner will not attempt to apply prior art against claim 3.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-6, 16 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Combination/subcombination:

It is improper to use a dependent claim to expand the scope of the claim from subcombination to combination.

The positive inclusion of “the surface” and “the storage unit” (claim 2) raises the question of whether the combination or subcombination is being claimed.

Note that the preamble of the claim 1 implies only the subcombination is being claimed.

Similar situation exist in claim 9 (see the recitation of “the surface” and “the storage unit sits” and claim 31 (see “a wastebasket”).

The examiner suggests the phrase “ that attaches to the surface” (claim 2, line 2) and claim 9, line 2, should be changed to – adapted to attach to the surface –; and the phrase “ that receives the storage unit and holds” (claim 2, line 3) should be changed to – adapted to receive the storage unit and hold --.

For purpose of this office action, the examiner will assume the “storage unit” and “surface” are being recited merely functionally.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 4-6 and 9, 11-12, 15, 16, 19-22 and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent number 2.074.248 to Barbour.

Regarding claims 1, 2, 4-6, 9, 12, 15-16, 19-22 and 27-31, Barbour '248 discloses an apparatus (figures 1-2) comprising a holder and a cover/concealing means (17) attached to the holder, wherein the cover is inherently sized to conceal in part a storage unit from being viewed in a first direction, wherein the first direction is directed toward a front elevation, and wherein the holder comprises a plate/securing means (5), a ring piece/platform/hanging means (1) attached to the plate, and a first mounting piece (13,23) attached to the ring piece, wherein the cover comprises a second mounting piece (18-22,27-29) connected to the first mounting piece, wherein the second mounting piece is detachable from the first mounting piece as well as the cover, wherein the apparatus includes a fencer (8).

With respect to claim 11, Barbour' 248 teaches an apparatus (above) comprising a storage unit (1) including a first mounting piece (5) connected to a surface and a second mounting piece (13) connected to a cover (17).

With respect to claims 29-31, claims 29-31 recited limitations similar to those recited in claims 1-2, 4-6, 9, 11-12, 15-16, 19-22 and 27-28, are therefore also read on Barbour.

Response to Arguments

9. Applicant's arguments filed July 11, 2005 have been fully considered but they are not persuasive.

Applicant's arguments with respect to Drawings, specification, and 112 rejections are fully considered but they are not persuasive as repeatedly pointed out in the office action. Applicant's arguments with respect to 102(b) rejection to Barbour as alleged on pages 21-42 are also considered but not persuasive. More particularly Applicant's argument that Barbour is nonanalogous art. It is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference "teach" what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, "read on" something disclosed in the reference, i.e., all limitations of the claim are found in reference, or are "fully met" by it. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789 (CAFC 1983). In the instant case, the examiner respectfully submits that all the limitations as recited in the claims are found in the reference of Barbour or are fully met by Barbour.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (571) 272-6818. The examiner can normally be reached on Mon. through Fri. from 9:00 AM-6:00 PM.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tan Le
Patent examiner
April 19, 2006



ANITA KING
PRIMARY EXAMINER